THIS OPINION WAS NOT WRITTEN FOR PUBLICATION
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Trial Section Merits Panel
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Paper No. 56

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

RICHARD A. LERNER, JOSEPH A. SORGE,
LUTZ RIECHMAN, and GREGORY WINTER
(07/941,762),

Junior Party,

v.

RICHARD A. LERNER and JOSEPH A. SORGE
(07/941,761),

Junior Party,

v.

GREGORY P. WINTER, ELIZABETH S. WARD,
and DETLEF GUSSOW
(08/332,046),

Senior Party.

Interference No. 104,272

Before SCHAFER, LEE, and TORCZON, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

JUDGMENT

(PURSUANT TO 37 CFR §§ 1.658 AND 1.662)

35 U.S.C. § 135(c) Notice: Failure to file a copy of any agreement regarding the termination of this proceeding may render the agreement and any resulting patents

INTRODUCTION

Senior party Winter has filed a request for adverse judgment (Paper No. 51). Junior party Lerner and Sorge have moved for no interference-in-fact between their involved applications (Paper No. 54). The motion is unopposed. The request is granted. The motion is granted for the reasons discussed below.

DISCUSSION

In order for an interference-in-fact to exist, the inventions claimed by the two different applicants must be directed to the same patentable invention. 37 CFR § 1.601(j). Two claimed inventions are the same patentable invention if one would have been anticipated by, or obvious in view of the other, and vice versa. 37 CFR § 1.601(n). In the instant case, the claims of the 07/941,761 ('761) application contain limitations that would not have been anticipated by, or obvious in view of, the claims of the 07/941,762 ('762) application, and vice versa.

In the '761 application, generic claims 17 and 31 are directed to methods for the production of a population of coexpression vectors comprising first and second polynucleotide sequences. As part of the methods, libraries of two types of cloning vectors are synthesized where each

type of vector contains a polynucleotide sequence having a restriction endonuclease recognition site upstream to the translation initiation site. Restriction endonuclease is added to cleave the polynucleotides at the recognition site and to leave ligation compatible ends. Thereafter the polynucleotides from the two different types of vectors are ligated to form the coexpression vectors. In the '762 application, the coexpression vectors are synthesized by a similar method, but the '762 process includes only a generic step of joining the two different types of polynucleotide sequences. There is nothing in the record to indicate that one skilled in the art would have been motivated to select the specific method of joining the two different polynucleotides as claimed by the '761 application in view of the '762 claims. Therefore the '761 claims are not anticipated or obvious in view of the '762 claims.

In the '762 application, generic claims 32, 45, 59, 71, 80, and 90 are directed to the production of polynucleotides and vectors containing such polynucleotides where the polynucleotides and vectors are capable of expressing the variable regions of the light (V_L) and heavy (V_H) chains of antibody molecules. Generic claims 17 and 31 of the '761 application are directed to the production of vectors

generally, not to vectors producing any particular proteins. There is nothing in the record to suggest that one skilled in the art would have been motivated to select the particular species of polynucleotides as claimed within the '762 application in view of the '761 claims.

Accordingly, since the '761 claims would not have been anticipated by, or obvious in view of, the '762 claims, and vice versa, no interference-in-fact exists between the claims of the two applications.

A final decision awards judgment based on a count. 37 CFR § 1.658(a). A claim designated as corresponding to a count is involved in the interference. 37 CFR § 1.601(f). Conversely, a claim not designated as corresponding is not involved in the interference. Even if claims might have been properly designated as corresponding, they are not involved for the purposes of judgment if they are not designated as corresponding. Junior party Lerner and Sorge submitted amendments in its '761 application adding claims (Paper Nos. 22 and 27), but there is no motion to designate additional claims as corresponding to the count. See 37 CFR § 1.633(c). Consequently, the claims proposed to be added by amendment are not before us for the purposes of this judgment.

ORDER

Upon consideration of the record of this interference, it is

ORDERED that judgment on priority as to Count 1 is awarded against senior party Winter;

FURTHER ORDERED that senior party Winter is not entitled to a patent containing claims 49 and 53-56 of Winter's 08/332,046 application, which correspond to count 1;

FURTHER ORDERED that, based on the record before us, junior party Lerner and Sorge is entitled to a patent containing claims 17-22, 24-26, and 29-32 of their 07/941,761 application, which correspond to count 1;

FURTHER ORDERED that, based on the record before us, junior party Lerner, Sorge, Riechman, and Winter is entitled to a patent containing claims 32-37, 39-41, 44, 45, 47-51 , 53-55, 58-67, 70-76, 78-86, and 89-97 of their 07/941,762 application, which correspond to count 1;

FURTHER ORDERED that the preliminary statements be returned unopened.

RICHARD E. SCHAFER
Administrative Patent Judge

JAMESON LEE
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

BOARD OF
PATENT
APPEALS AND
INTERFERENCES

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Patent and Trademark Office
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Interference Trial Section

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INTERFERENCE NO. 104,272

9 Please review the attachment and, if no corrections are necessary, please circulate as indicated.

9 If corrections are necessary, please mark the attachment accordingly and return it to me.

Thank you for your assistance in this matter.

Attachment

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